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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197504
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

OMEGA, S.A.,

OPPOSER,

v.

ALPHA PHI OMEGA,

APPLICANT.

Opposition Nos.  
91197504 (Parent) &  
91197505 (Child)

Serial Nos.  
77950436 & 77905236

**REPLY TO OPPOSER'S OPOSITION TO SUPPLEMENTAL BRIEF  
IN SUPPORT OF  
ALPHA PHI OMEGA'S MOTION FOR SUMMARY JUDGMENT**

The Board raises an interesting question when it directs the parties to brief whether a Dilution Plaintiff “must establish that its mark became famous prior to defendant’s use of its subject mark in commerce as to any goods or services or whether [it] must establish that its mark became famous prior to defendant’s use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant’s subject application or registration.” Apparently Omega’s strategy is to ignore or avoid the question presented by the Board. Its lead argument either ignores this question or at least contends that from their perspective, *neither* is the correct answer.

In so ignoring the question presented, they want the Board to believe that the Federal Circuit somehow invalidated the statutory requirement that a successful dilution claim is only viable against one who commences use of a challenged mark or tradename after the allegedly diluted mark has become famous.

Subject to the principles of equity, the owner of a famous mark . . . shall be entitled to [relief] against another person who, at any time after the owner's mark has become famous, commences use of a

mark or trade name in commerce that is likely to cause dilution.

15 U.S.C. § 1125(c)(1). The gist of their argument is that the Federal Circuit somehow implicitly held that this statute is either unconstitutional, otherwise invalid, or at least is inapplicable to TTAB proceedings. Based upon this aberrant assumption, Opposer asserts that it need only prove the attainment of fame by the time of the filing of the opposed trademark registration applications. In *Toro Company v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001), the Board did hold that for a dilution based Opposition *to an ITU application*, the pertinent date for scrutinizing the fame of an Opposer's mark is the filing date of the opposed ITU application, a rational application of the dilution act, considering that with an ITU application, the filing date is the Applicant's constructive first use date. But as the Board also correctly noted in *Toro*, *when a use based application is opposed* on dilution grounds, Opposer must prove that its mark became famous prior to the Applicant's use of the opposed mark. *Toro Company*, 61 USPQ2d at 1174, n.9. Omega contends the Federal Circuit overruled this distinction when it quoted the excerpt from *Toro* dealing with opposed ITU applications. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1375 (Fed. Cir. 2012). It is quite an illogical leap to contend that because the Federal Circuit quotes the *Toro* excerpt relating to ITU oppositions, it has abrogated the legislative requirement that to show fame for dilution purposes, the proponent must prove that its mark was famous *prior* to the adoption of the allegedly diluting mark or tradename. The Federal did not so hold. If the issue before the Federal Circuit was whether the statute is either unconstitutional, otherwise invalid, or at least is inapplicable in relation to TTAB proceedings, one would think the Federal Circuit would have so said. But that was not the issue in *Coach*. To imagine that the Federal Circuit so significantly changed the law without expressly saying so, and held that the statute is either unconstitutional, otherwise invalid, or at least is inapplicable in relation to TTAB proceedings is nothing other than a spurious stretch.

Stuck with the fact that its proof offered to show fame is sales and marketing expenditures from 2000 to 2009, Opposer now offers a clever argument to the effect that the opposed applications which recite first use dates as early as 1930 and as early as 1980 should, in effect, be treated as ITU applications because the Applicant's Executive Director was not with Alpha Phi Omega when it was founded in 1925 and thus has no personal knowledge of the *exact first use day*.

This clever suggestion misses the point. The Applications for Registration in issue do not even purport to recite *exact* first use dates, rather the coat of arms application merely recites use since "at least as early as 1930" and the clothing application recites use since "at least as early as 1980."

Discovery irrefutably establishes the accuracy of these claimed dates. Indeed nowhere in Opposer's response to the Motion for Summary Judgment did it even suggest any error in the recited first use dates. Had Opposer actually had grounds to question whether the Alpha Phi Omega tradename was adopted in 1925, or if Opposer actually had grounds to question whether the Alpha Phi Omega marks were adopted in the 1920s, it would have been incumbent on it to come forward at the Summary Judgment stage to show the existence of such a genuine issue of material fact. As a result of the Supreme Court's *Anderson v. Liberty Lobby* line of cases, in opposing a properly brought Motion for Summary Judgment, the respondent is required to come forward to demonstrate the existence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986) (emphasis added). *Nowhere* in Opposer's response to the Motion for Summary Judgment did it come forward with even an attempt at showing that the Alpha Phi Omega marks were not in use as specified in the registration applications, other than a simple assertion that Alpha Omega's Executive Director has no knowledge of the *exact* first use date.

There is good reason of course why this was not raised in Opposer's response to the Motion for Summary Judgment. It is not a genuine issue. The declaration with the application to register the ΑΦΩ coat-of-arms verifies the mark has been used for jewelry since at least as early as 1930 and discovery irrefutably establishes the accuracy of this claim. *See* Defendant's Exhibit 5 to Docket Entry #81 (March 1929 newsletter of the fraternity identifying the L.G. Balfour Co. as the "Official Jewelers to Alpha Phi Omega" and a full page price list of "Alpha Phi Omega Jewelry" including the fraternity's "Standard Official . . . Badge" and pertinent to the coat-of-arms mark, "rings, tie pins" bearing the "Coat of Arms").

It is also significant to note, in addition to use of the coat-of-arms mark with jewelry since the 1920s, Applicant has also used its ΑΦΩ Greek letters for jewelry continuously since the founding of the fraternity in 1925. (London Depo. 113:9–22). As noted in our opening brief, in statement of undisputed fact No. 11, we note the concurrent use by the parties of their respective marks for 90 years. In Opposer's response to the Motion for Summary Judgment, it does not dispute the concurrent use for 90 years, and for that reason alone is deemed to have admitted the Alpha Phi Omega marks have been in use for 90 years.

The declaration with the application to register ΑΦΩ for "headwear, jackets, shirts, and sweat shirts" verifies that this insignia has been used for clothing since at least 1980 and discovery irrefutably establishes the accuracy of this claim. *See* Defendant's Exhibit 6 to Docket Entry #81 (a 1976 publication of the fraternity containing a photograph of multiple members of the fraternity wearing clothing items such as shirts, jerseys and hats bearing the ΑΦΩ insignia.)<sup>1</sup>

Now, in footnote 2 to its supplemental brief, Opposer asks the Board to ignore the

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<sup>1</sup> It is curious to note that Applicant owns a subsisting registration of the mark ALPHA PHI OMEGA for the same goods. *See* the Deposition Exhibit marked as Plaintiff's Exhibit 9 submitted with Applicant's opening brief. One must wonder why Opposer believes itself to be injured by registration of the letters ΑΦΩ when it has not challenged Applicant's registration of the literally equivalent mark ALPHA PHI OMEGA for the identical goods? )

discovery evidence supporting the first use dates (1) because the discovery documents are not formally “authenticated,” (2) and because the discovery documents are appended as exhibits to a Reply brief.

As for the “authentication” objection, documents produced in discovery may properly be submitted as evidence in association with a Motion for Summary Judgment. FED. R. CIV. P. 56 (c)(1). Separate formal “authentication” is not the test. If the respondent has grounds to challenge whether the document could not constitute admissible evidence, it can do so pursuant to subsection (c)(2) of Rule 56. *See also* TBMP § 528.05(a)(1), n. 8.

As for the fact that the documents were appended to a Reply brief, Opposer suggests exhibits first introduced with a Reply brief are improper based upon *Provenz v. Miller*, 102 F.3d 1478 (9<sup>th</sup> Cir. 1996). *Provenz* does not so hold. Rather, quite to the contrary, *Provenz* is concerned with surprise and ambush, not documents previously produced in discovery. If the document was previously produced in discovery, it may be considered. In *Provenz*, the Court actually held it is *not improper* to consider documents introduced with a Reply brief if the documents had previously been produced in discovery.

[*Provenz* does not hold] for the proposition that a party may not offer new evidence with a reply . . . . [I]n *Provenz*, the Ninth Circuit refused to find the district court abused its discretion in denying the plaintiffs' motion for reconsideration based on an ex-employee's declaration because the ‘plaintiffs learned about this employee well before plaintiffs filed their opposition.’ *Id.* at 1483. Pacific Capital's own August 7, 2009 email is not new evidence . . . . It strains reason to argue that a Pacific Capital document confirming a transaction in the subject real property only came to the bank's attention upon the filing of Debtor's reply. *Pacific Capital knew about these documents* long before it opposed Debtor's motion.

*Pac. Capital Bancorp, N.A. v. E. Airport Dev., LLC (In re E. Airport Dev., LLC)*, 443 B.R. 823, 828-829 (B.A.P. 9th Cir. 2011) (emphasis added). *See also First Specialty Ins. Corp. v.*

*633 Partners, Ltd.*, 300 Fed. Appx. 777, 788 (11th Cir. Fla. 2008) (“Appellants' counsel participated in the underlying case, *they cannot claim surprise or lack of knowledge*”) (emphasis added).

There is actually an irony in play here. After applicant filed the pending Motion for Summary Judgment, Opposer moved for and obtained a suspension of the motion to allow Opposer to take more discovery, and when it did so, the documents of concern were produced in response to the discovery requests. The documents were provided to Opposer well prior to its response to the Motion for Summary Judgment. Opposer is not at all in a position to claim it is now surprised by the documents.

The truth is what it is and that should be what matters to the Board. In Opposer’s response to the Motion for Summary Judgment it did not come forward to question Applicant’s first use dates, indeed it could not have credibly done so considering what was irrefutably shown in discovery. Nothing “surprising” was appended to our Reply. Nowhere in Opposer’s response to the Motion for Summary Judgment did it question the use dates recited in the registration applications, the accuracy of which had been verified by discovery. Further, Opposer did not refute statement of undisputed fact # 11 relating to Applicant’s use of its marks over the past 90 years. It specious for Opposer to now cleverly suggest use has not been shown predating the application filing dates has not been shown. Thus. Pursuant to 15 U.S.C. § 1125(c)(1), Opposer must prove that its mark became famous prior to the Applicant’s adoption of it tradename and marks, not merely fame just prior to the filing dates. *Toro Company*, 61 USPQ2d at 1174, n.9.

Regardless of Opposer’s apparent attempt to ignore the question presented by the Board, as discussed in our opening supplemental brief, the answer to the Board’s question appears to be the Opposer “must establish that its mark became famous prior to defendant’s use of its subject

mark in commerce *as to any goods or services*,” not whether all it has to “establish [was] that its mark became famous prior to defendant’s use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant’s subject application or registration.”

Even if the rule were otherwise though, it would make no difference in this case. Even if Omega only needed to prove fame prior to the 1980 to succeed with a dilution claim relating to the application to register the AΦΩ mark for apparel, Omega’s did not come forward with any proof to show fame for dilution purposes prior to the 1980s. All Opposer has come forward with to support its burden to prove fame is sales and marketing data and media attention *from this century*. The putative “proof” presented by Opposer, sales and marketing data from 2000 to 2009 is completely irrelevant to the question hand.

So whether the key date for which Omega must prove fame for dilution purposes is 1925 when Alpha Phi Omega adopted its tradename and membership marks, or by at least 1929 when the AΦΩ coat-of-arms was in use for jewelry, or before the marks were used on clothing at least as early as 1980 really doesn’t matter in this case because Omega has not shown fame for dilution purposes preceding *any of those dates*.

Because Opposer bears the burden of proof, it must come forward at the Summary Judgment juncture with a showing its marks became famous for dilution purposes prior to Alpha Phi Omega’s commencement of use of its marks. The showing made by Opposer of sales, marketing, and publicity from 2000 to 2009 is totally irrelevant to the dilution issue here, even if Opposer only had to show fame prior to 1980 to succeed with a dilution based Opposition to the application to register AΦΩ for apparel. When the party bearing the burden of proof fails to come forward in its opposition to a Motion for Summary Judgment to demonstrate there is a



genuine issue of material fact, the tribunal “shall then grant summary judgment.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986).

### **CONCLUSION**

In relation to the question presented by the Board, the answer seems to be the Opposer “must establish that its mark became famous prior to defendant’s use of its subject mark in commerce *as to any goods or services*,” not whether all it has to “establish [was] that its mark became famous prior to defendant’s use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant’s subject application or registration.”

Regardless, under the facts of this proceeding, the determination of the question really makes no difference. The showing made by Opposer of sales, marketing, and publicity from 2000 to 2009 is totally irrelevant to the dilution issue here, even if the key date in relation to the application to register ΑΦΩ for apparel is 1980, rather than 1925 when ALPHA PHI OMEGA adopted its trade name and marks.

Respectfully requested,

/jackawheat/

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### **CERTIFICATE OF SERVICE AND ELECTRONIC SUBMISSION**

I hereby certify that a true copy of this REPLY TO OPPOSER’S OPPOSITION TO SUPPLEMENTAL BRIEF IN SUPPORT OF ALPHA PHI OMEGA’S MOTION FOR SUMMARY JUDGMENT is being filed electronically with the U.S. Patent and Trademark

Office using the ESTTA service, and a copy has been served on counsel for Opposer by mailing said copy this 3rd day of December, 2015, via First Class Mail, postage prepaid, to:

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